

REMARKS

Reconsideration and entry of the following remarks is respectfully requested. Claims 1-25 are pending.

Claims 1, 2, 7, 8, 13, 14, 15, 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai in view of Henderson and Fields. This rejection is respectfully traversed.

The Examiner admits that Kawai does not teach that the digitizer has an input surface defining a space that is mapped to coincide with the display via computer readable medium, at the host computer, having stored thereon sequences of instructions for mapping the space to the display, the digitizer being constructed and arranged to have no display features. The Examiner cites Fields as teaching these features and contends that it would have been obvious to modify Kawai to have the input system mapped to the display as taught by Fields because "it is well known in the art of digitizers to map the location of the stylus on the input surface space to the display surface..."

Applicants submit that if such a modification were made, there would be no display at each terminal 507 to 510 of Kawai and this modification would be improper since Kawai requires a display at each terminal 507-510. In Kawai the Device or Terminal (Item 507, Optical Signal Transmitting/Receiving Unit) has a display with integrated digitizer. Kawai states at column 3, lines 25-37:

When an attendant asks questions, or makes any changes such as an addition, first, the image which is identical to the image on the projector 521 is called on the screen of the nearby terminal among the terminals 507 to 510, which will be explained later. Then the attendant inputs characters and figures on a digitizer equipped on the screen of the terminal using a pen or the like, and can indicate questions, or parts of the image to be added or corrected. Accordingly, the inputted contents on the digitizer are super-imposed on the image on the projector 521 in the both conference rooms and on the screens of the terminals, therefore all conference attendants can see the questions or added or corrected contents.

Furthermore, Kawai states at column 11, 47-52:

A conference attendant can watch the displayed image on the liquid crystal display unit 201 of its terminal, and in a case where he or she wants to designate another party of the conference system, he or she connects to the other conference room by displaying a list of the other parties and pointing to the desired party on the list with the pen 544.

Hence, a display at each terminal 507 to 510 of Kawai is critical to the proper operation of the system of Kawai and thus, Kawai would not be modified in any manner that would remove the display feature.

The Examiner is reminded that the proposed modification cannot change the principle operation of a reference or render it unsatisfactory for its intended purpose. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.” MPEP § 2143.02, Rev. 2, May 2004 at p. 2100-132 (Citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). “If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Id. (Citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In addition, Fields merely discloses the use of a single digitizer. With regard to claim 2, there is no teaching or suggestion in the prior art of record of a plurality of un-tethered (e.g., portable) digitizers each having no display yet all being mapped to the same display region. With the claimed invention, multiple portable wireless digitizers correspond to the same display space, rather than each digitizer having its own individual display.

Furthermore, the independent claims define that the digitizer is un-tethered, and due to the wireless communication, is portable and can advantageously be moved throughout a conference room. There is no teaching in Kawai that the device 541 is un-tethered. Kawai is silent as to how the devices 541 are powered. The Examiner cannot assume that there is no power cable (thus, being un-tethered) providing power to each device 541 in rejecting the claims. In Kawai, since each device 541 requires

line of site (optical) communication and cannot be moved from its fixed position, it is likely that there is a power cable for each device.

For these reason, the rejection of claims 1, 2, 7, 8, 13, 14, 15, 20 and 21 should be withdrawn.

Claims 3, 9 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai in view of Fields and Henderson and further in view of Nishitani et al. Applicants submit that it would not have been obvious to use radio frequency transceiver at each digitizer and a single radio frequency transceiver associated with the host computer in the system of Kawai, since such a substitution would destroy the invention of Kawai, which requires an optical communication scheme. See Ex parte Hartman, 186 U.S.P.Q. 336, 337 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references).

Claims 4, 10, 17 and 23-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai in view of Fields and Henderson and further in view of Ieperen. These claims depend from the independent claims 1, 8 and 14 and above and are considered to be allowable for the reasons advanced above.

Claims 5, 11 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai in view of Fields and Henderson and further in view of Lin. Claims 5, 11 and 18 depend from the independent claims 1, 8 and 14 and above and are considered to be allowable for the reasons advanced above.

Claims 6, 12 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai in view of Fields and Henderson and further in view of Bi et al. Claims 6, 12 and 19 depend from the independent claims 1, 8 and 14 and above and are considered to be allowable for the reasons advanced above.

Claim 22 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka in view of Henderson. This rejection is not understood since the Examiner then uses Kawai and Fields in making the rejection. In any event, claim 22 defines a digitizer similar to that of claim 1 (e.g., no display, un-tethered) and is considered to be allowable for the reasons advanced above.

Kaye et al. – Appln. No. 09/986,623

All rejections having been addressed, it is respectfully submitted that this application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "E. Stemberger", written in black ink.

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